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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/660,338 | 09/10/2003 | Maurice L. James | 005950-843 | 5989 |

21839 7590 12/29/2004

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EXAMINER

TUCKER, PHILIP C

ART UNIT PAPER NUMBER

1712

DATE MAILED: 12/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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| | | | |
|------------------------------|--------------------------------------|-------------------------------------|--|
| Office Action Summary | Application No. 10/660,338 | Applicant(s) JAMES ET AL. | |
| | Examiner Philip C Tucker | Art Unit 1712 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11-18 and 20 is/are allowed.
- 6) ☒ Claim(s) 1-10, 19 and 21 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-4, 6 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Armentrout (2836555).

Armentrout teaches bentonite pellets which have been compressed using a pressure of at least 2000 pounds per square inch (see column 2, lines 33-37). Such would inherently have the density and particle survival within the scope of the present invention. The bentonite is taught to have levels of water up to 10% (column 5, lines 17-20), the source of which, connate or nonconnate, is not seen as a distinguishing factor. The method of making of claim 21, is not a distinguishing feature in a product by process claim (In re Thorpe 227 USPQ 964).

3. Claims 1, 7-10 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by James et al (5657822).

James teaches bentonite nodules which have densities (column 2, lines 29-33) and sizes (column 9, line 60 – column 10, line 8) within the scope of the present invention. Since the densities are the same, the nodules would clearly have the same survival rate as being claimed in the present invention. The teaching of pillow shaped in

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claim 7 is not distinguishing, since pillows may be round. The teaching of flattened spheres having a minor diameter as much as 0.99 times the major as in claim 10, is not seen as distinguishing, since such level of imperfection of the bentonite spheres would naturally occur in their production. The method of making of claim 21, is not a distinguishing feature in a product by process claim (In re Thorpe 227 USPQ 964).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-6 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over James (5657822) in view of Alexander (4462470) or Armentrout (2836555).

James teaches bentonite nodules which have densities (column 2, lines 29-33) and sizes (column 9, line 60 – column 10, line 8) within the scope of the present invention. Since the densities are the same, the nodules would clearly have the same survival rate as being claimed in the present invention. James differs from the present invention in that the level of water in the nodule is not disclosed. Alexander discloses that bentonite used in forming pellets may comprise up to 15% moisture (column 4, lines 41-46), and Armentrout teaches that commercially available dry bentonite useful for forming pellets may contain as much as 10 % water (column 5, lines 15-20). It would be obvious to one of ordinary skill in the art to utilize the bentonite of Alexander or

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Armentrout, in the invention of James, given the teaching of Alexander and Armentrout, that such are useful in the forming of bentonite pellets. The source of the water connate or nonconnate, is not seen as a distinguishing factor.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

There is no antecedent basis for "said continuous manufacture machine" in claim 19 or parent claim 11. The claim also does not further limit the scope of claim 11.


8. Claims 11-18 and 20 are allowable over the art of record.

9. The following is a statement of reasons for the indication of allowable subject matter: The prior art fails to teach the use of a continuous press roll machine in forming the bentonite nodules having the properties within the scope of the present invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip C Tucker whose telephone number is 571-272-1095. The examiner can normally be reached on Monday - Friday, Flexible schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Philip C Tucker
Primary Examiner
Art Unit 1712

PCT-3229